

REMARKS

Applicant has carefully studied the outstanding Office Action and thanks the Examiner for careful review of this Application. The present amendment is intended to place the application in condition for allowance and is believed to correct a typographical error in the claims. Favorable reconsideration and allowance of the application is respectfully requested.

Change of Correspondence Address

Applicant has submitted a new power of attorney for Customer No. 22918, a copy of which is included as part of this Amendment and Response, following the signature page. Applicant requests that further correspondence be addressed to:

Customer No. 22918
Perkins Coie LLP
P.O. Box 2168
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and that the customer number for this application be updated within the USPTO computer systems.

Rejection of Claims

Applicant submits that the following examples of differences between the prior art and the claimed invention make clear that all claims of the present application are allowable. The Office Action states that the Berstis reference (U.S. Patent 6,901,367) provides an electronic mail generation system (page 2 of the Office Action) which sends electronic mail to a mail recipient (page 2 of the Office Action) which is part of a survey

system (page 3 of the Office Action). Applicants dispute this characterization of the reference.

The Office Action cites to Figure 4, element 403 of Berstis for the proposition that Berstis performs the "determining, as part of an electronic mail generation system, a preferred language" element of claim 1. Step 403, as described in the specification, is part of a process whereby email is received (step 401), it is determined what language the email message was transmitted in (step 403), the email message is translated (step 423) and the email message is displayed (step 427) for the user. Thus, all of this activity occurs on a client machine, translating incoming email for a user. As illustrated in Fig. 2, the email is received in an email client, such as Microsoft Outlook®, and is translated for the user at the client. See col. 6, lines 5-32. This translation may occur automatically on behalf of the user for email that arrives in selected languages. See col. 6, lines 35-44.

The claimed invention of claim 1 generates an email message in a preferred language. The clear purpose of this invention is to avoid requiring a user to have software which automatically translates the message upon receipt. Instead, the email is generated in the language determined to be the preferred language for the user. Otherwise, messages could be sent in a native language of a sender, and the messages would be translated on the receiving end by the method and apparatus of Berstis. Thus, Berstis provides an alternative option for solving the same problem, but one that puts the burden of processing on the receiving computer, rather than on the sending computer as in the claimed invention.

The rejection of claim 2 further illustrates this issue. Claim 2 requires that the email be sent to an electronic mail recipient. Sending an email is clearly related to transmitting the email message over a network, not displaying the email message on an output device. Moreover, the email may not be sent before it is written (as in Claim 1). Thus, the process of Figure 4 or Berstis and the apparatus of Figure 2 of Berstis are not appropriate based on the citation of the Office Action. Clearly, translation occurs upon

receipt of the email message in Berstis, rather than prior to transmission as in the claimed invention.

The Office Action further states that the system of Berstis is part of a survey system. Berstis presents a basic email client with an inbox, outbox, as one would expect to find in a product such as Microsoft Outlook®, for example. Berstis provides no information about generation of surveys, let alone translation of emails related to such surveys prior to sending such emails.

Perhaps the clearest indication that the system of Berstis is not used for the same process as the claimed invention is provided at col. 7, lines 13-32. Therein, Berstis illustrates that the original message and the translated message are both displayed to the user, with only parts of the message translated. However, the claimed invention claims writing the header and the body in the preferred language – contradicting the approach described in Berstis. The Berstis system allows an end-user to spot problems in translation on their own system by providing both the original language of the email and the translated language. The claimed invention writes the entire message in the preferred language, eliminating the need for a user to review the message in any other language.

For at least the foregoing reasons, Applicant respectfully submits that claims 1, 2 and 6 are clearly allowable. The Office Action equates claim 12 with claim 1. While Applicant submits that claims 1 and 12 are distinct and separately patentable, Applicant also submits that the showing of patentability of claim 1 thus overcomes the rejection of claim 12. All other claims of the application either depend on claim 1 or claim 12, directly or indirectly. Thus, for at least the foregoing reasons, Applicant respectfully submits that the applicable rejections have been overcome and that the claims are in condition for allowance.

The Office Action rejects claims 10-11 and 21-22 over Berstis in view of Crapo (U.S. Published Patent Application 2004/0064371). Applicant submits that these rejections are overcome based on the showing in relation to claims 1 and 12 that Berstis does not provide all elements of claims 1 and 12. Accordingly, Applicant

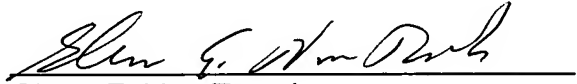
submits that claims 10-11 and 21-22 are allowable and the rejection has been overcome. Additionally, Applicant requests copies of United States Provisional Patent Applications 60/150,461 and 60/150,237, from which Crapo claims priority. Crapo otherwise does not have a filing date prior to Applicant's priority date, and thus Applicant submits that a full examination requires a determination of whether the Crapo priority date supports what Crapo is cited for.

CONCLUSION

Applicant submits that this application is now in condition for allowance. No fees are believed to be due beyond those for which authorization to charge the Deposit Account was specifically granted, however, the Commissioner is authorized to charge any underpayment in fees to Deposit Account No. 50-2207, including any funds necessitated due to an accompanying check being drawn on an account with insufficient funds.

Respectfully submitted,
Perkins Coie LLP

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